II. RESPONSE TO OFFICE ACTION

A. Status of the Claims

Claims 1 and 3-49 were pending at the time of the Action. Claims 1, 3-8, 10-11, and 22-49 stand rejected, and claims 9 and 12-21 are objected to. Claims 5, 7, 9-10, 12-13, 15-16, 20-21, 27-33, and 49 have been canceled, claims 1, 4, 6, 8, 11, 14, 17-19, 22-26, 34-35, 40, and 43 have been amended in the Amendment contained herein, and claims 50-109 have been added. No new matter is added by the Amendment and new claims, and support for the Amendment and new claims can be found in the specification and claims as originally filed. Therefore, claims 1, 3-4, 6, 8, 11, 14, 17-19, 22-26, 34-48, and 50-109 are pending after entry of the Amendment.

B. Examiner Interview Summary

On September 27, 2005, Applicants' representative Mark Wilson phoned Examiner Elhilo. Applicants and Examiner Elhilo discussed the final Official Action dated August 2, 2005 and potential strategies for obtaining allowance of the claims. Examiner Elhilo noted that claims 9 and 12-21 would be allowable if rewritten in independent form including all the limitations of the base claim and any intervening claims. Examiner Elhilo indicated that if Applicants import the limitations from claims 9 and 12-21 into independent claim 1, he would consider such amendments. Further, Examiner Elhilo indicated that he would allow the claims if such amendments place the claims in condition for allowance. As detailed below, Applicants have amended the claims, in part, to incorporate several of Examiner Elhilo's suggestions. Applicants again wish to thank Examiner Elhilo for his time and attention to this file so that its prosecution can advance to issuance.

C. The Obviousness Rejections Are Overcome

1. Claims 1, 3-4, 6, 8, 11, 22-26, and 34-48 are not Obvious Over Laurent in View of Lim

Claims 1, 3-4, 6, 8, 11, 22-26, and 34-48 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Laurent et al. (US 2002/0046431) ("Laurent") in view of Lim et al. (US 6,461,391) ("Lim"). Applicants traverse this rejection.

Applicants note that independent claim 1 (which all of the other pending claims either depend from or incorporate by reference) has been amended herein, in part, to incorporate some or all of the limitations from claims 5, 7, 12, 13, 15, and 16. The limitations imported from claims 12, 13, 15, and 16 involve claimed formulae (III) and (IV). Applicants note that the Office Action dated November 17, 2004 states that the prior art of record (including Laurent and Lim) does not teach or disclose para-phenylenediamine compounds of the claimed formulae (III) and (IV). Applicants concur that para-phenylenediamine compounds of the claimed formulae (III) and (IV) are not taught or disclosed by the prior art. For at least this reason, the obviousness rejection is improper and should be withdrawn, as a *prima facie* case of obviousness does not exist when the prior art references fail to teach or suggest each and every limitation of the claims. *See In re Royka*, 490 F.2d 981 (CCPA 1974); MPEP § 2143.03.

With regard to those compounds encompassed by claim 1 that do not involve formulae (III) or (IV), Applicants submit that the obviousness rejection is nevertheless improper and should be withdrawn. The Action fails to establish that there is a motivation to combine the teachings of Laurent with those of Lim. When obviousness is based on the teachings of multiple prior art references, the Action much establish some "suggestion, teaching, or motivation" that would have led a person of ordinary skill in the art to combine the relevant prior art teachings in the manner claimed. *See Tech Air, Inc. v. Denso Mfg, Mich, Inc.*, 192 F.3d 1353, 1358-60 (Fed. Cir. 1999); *Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc.*, 75 F.3d 1568, 1572 (Fed. Cir. 1996).

The Action contends that a motivation to combine exists in this case because "the use of patents as references is not limited to what the patentees describe as their own inventions or to the problems with which they are concerned." The Action, p. 3. While this may be true, it does not change the fact that the Action provides **no** substantive explanation of **why** or **how** a person of skill in the art would be motivated to combine the teachings of Laurent with those of Lim to achieve what Applicants have done. The Action merely puts forth the conclusory statement that "there is

sufficient motivation to a person of skill in the art to be motivated to substitute para-phenylenediamine oxidation bases of Laurent et al. by the cationic tertiary para-phenylenediamines of Lim." The Action, p. 3. As stated in MPEP § 2143.01, "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination."

Laurent teaches a specific dyeing composition directed to slowing the development of the oxidizing agent, requiring a composition comprising a combination of either an oxyalkylated fatty alcohol or a glycerolated fatty alcohol and a hydroxylated solvent in addition to an oxidative dye and a cationic amphiphilic polymer comprising at least one fatty acid. Laurent broadly discloses suitable oxidant dyes, such that "representative oxidation dyes include ortho- phenylenediamines, para-phenylenediamines, double bases, ortho-aminophenols, para-aminophenols, heterocyclic bases and their acid addition salts." Laurent, paragraph 0264. The para-phenylenediamines are themselves broadly disclosed in a generic formula, wherein the thousands of potential structures include, once the "R" groups have been suitably parsed, pyrrolidine derivatives. Lim discloses "useful hair coloring systems [that] comprise quaternized pyrrolidone compounds." Lim, Abstract. Why replace the generically disclosed pyrrolidine containing bases of Laurent with the quaternized bases of Lim? **Nothing** in either reference provides a motivation or suggestion of the **particular** desirability to modify the **specific** compositions of Laurent directed to slowing the rate color formation with the **particular** quaternized dyes of Lim, as opposed to any other possible oxidant base.

It is well settled that "[t]he examiner bears the initial burden of factually supporting any *prima facie* case of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under ***no*** obligation to submit evidence of nonobviousness." MPEP § 2142. Because the Action fails to meet this evidentiary burden, Applicants respectfully request that the rejection of claims 1,

3-4, 6, 8, 11, 22-26, and 34-48 as being obvious over Laurent in view of Lim be reconsidered and withdrawn.

2. The Obviousness Rejection of Claims 30-31 is Rendered Moot

Claims 48-54 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Laurent and Lim in view of Zofchak et at. (US 6,315,991). This rejection is rendered moot because claims 30-31 have been canceled by the Amendment contained herein.

D. Conclusion

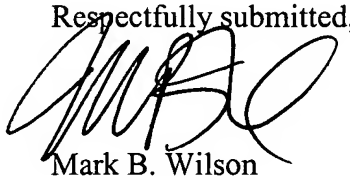
Applicants believe that the present document is a full and complete response to the Office Action dated August 2, 2005. The present case is in condition for allowance, and such favorable action is respectfully requested.

III. REQUEST FOR EXTENSION OF TIME

Pursuant to 37 C.F.R. § 1.136(a), Applicants petition for an extension of time of one month to and including December 2, 2005, in which to respond to the Office Action dated August 2, 2005. Pursuant to 37 C.F.R. § 1.17(a)(2), a check in the amount of $120.00 is enclosed, which is the fee for a one-month extension of time for a large entity. If the check is inadvertently omitted, or should any additional fees under 37 C.F.R. §§ 1.16 to 1.21 be required for any reason relating to the enclosed materials, or should an overpayment be included herein, the Commissioner is authorized to deduct or credit said fees from or to Fulbright & Jaworski Deposit Account No. 50-1212/LORE:007US.

The Examiner is invited to contact the undersigned Attorney at (512) 536-3035 with any questions, comments or suggestions relating to the referenced patent application.

Respectfully submitted,



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